

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 25

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Ex parte DAVID R. FERGUSON, AN N. HONG,  
DANI SULEMAN and GREGORY L. WHITTEMORE

**MAILED**

**OCT 28 2003**

U.S. PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Appeal No. 2002-0799  
Application No. 08/947,435

**ON BRIEF**

Before KRASS, RUGGIERO and DIXON, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

**DECISION ON APPEAL**

This is a decision on appeal from the final rejection of claims 1-28, 30-46 and 51. Claims 47-50 and 53-83 have been indicated by the examiner as being directed to allowable subject matter.

The invention is directed to a computer based document management system. The invention seeks to automatically import, store, organize and manipulate a document collection with minimal user interaction in an efficient manner. In particular, a document is imported into the computer system, that document is then stored in a memory location, attribute data is automatically extracted from that document and a data structure is generated for that document, wherein the data structure contains the attribute data in a standardized format regardless of document type or document format.

1. A method for managing a document collection in a computer system, said method comprising the steps of:

importing a document having a first format into a collection of documents in the computer system, wherein the collection of documents is organized within the computer system in accordance with a hierarchy of electronic folders;

storing the document in a memory location;

automatically extracting attribute data from the document;

generating a data structure for the document, wherein said data structure contains the attribute data in a second format independent of said first format, and wherein said data structure is stored and maintained in memory separate from the imported document and;

linking the imported document to a first electronic folder if the attribute data contained in said data structure matches a set of predefined criteria corresponding to the first electronic folder.

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The examiner relies on the following references:

Zarmer et al. (Zarmer)	5,625,818	Apr. 29, 1997
Fujisawa et al. (Fujisawa)	5,628,003	May 06, 1997
Malone et al. (Malone)	5,727,175	Mar. 10, 1998 (filed Jun. 07, 1995)

Claims 1-28, 30-46 and 51 stand rejected under 35 U.S.C. §103. As evidence of obviousness, the examiner cites Zarmer with regard to claims 1, 2 and 51, adding Fujisawa with regard to claims 3-10 and further adding Malone to this combination with regard to claims 11-28 and 30-46.

Reference is made to the briefs and answer for the respective positions of appellants and the examiner.

#### OPINION

In rejecting claims under 35 U.S.C. §103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must

stem from some teachings, suggestions or implications in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1040, 228 USPQ 685, 687 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1051, 189 USPQ 143, 146-147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the briefs have not been considered and are deemed to be waived [see 37 CFR 1.192 (a)].

With respect to independent claims 1 and 51, the examiner applies the teachings of Zarmer as follows:

“importing a document...” is said to be disclosed at column 6, lines 19-40, with column 7, lines 18-27; column 12, lines 41-48; and column 18, lines 17-23 providing disclosure for organizing a collection of documents according to a hierarchy of electronic folders and for storing the documents in a memory location.

“automatically extracting attribute data from the document” is said to be taught by Zarmer at column 18, lines 24-34.

“generating a data structure for the document” is said to be taught at column 23, lines 40-51 and column 24, lines 48-63, with the data structure containing attribute data in a second format independent from the first format being taught at column 24, lines 6-18 and column 4, lines 41-49. The examiner contends that “linking the imported document to a first electronic folder” is taught at column 6, lines 12-15 and 35-40.

The examiner recognizes that Zarmer does not teach that the data structure is stored and maintained in memory separate from the imported document and that the attribute data in the data structure matches a set of predefined criteria corresponding to the first electronic folder. But, the examiner finds that it would have been obvious “to have a set of predefined criteria because the information in the data structure is

arranged a certain way in the computer memory with the attributes in the data structure being those of files marked as hidden, read-only, and archive" (answer-page 4).

We agree with appellants that the examiner has not set forth a prima facie case of obviousness since Zarmer does not disclose or suggest the steps of automatically extracting attribute data from an imported electronic document, generating a separate data structure, in which the extracted attribute data is stored and maintained in memory separate from the imported document, and linking the imported document to an electronic folder *if* the attribute data contained in the data structure matches a set of predefined criteria associated with the electronic folder.

This non-disclosure by Zarmer is not dispositive of the case because the examiner recognized these deficiencies. However, the examiner's reasoning as to why it would have been obvious to have provided for these deficiencies in Zarmer is faulty. The examiner's reasoning, in toto, is that the artisan would have found it obvious "to have a set of predefined criteria because the information in the data structure is arranged a certain way in the computer memory with the attributes in the data structure being those of files marked as hidden, read-only, and archive" (answer-page 4). Appellants do not deny that they have not invented storage of attributes, per se. Rather, the claimed invention is directed to a particular set of steps of a method. The

examiner's rationale does not begin to answer the question as to why the artisan would have found the totality of these steps to have been obvious, even though the prior art did not suggest the claimed method and even though it may have been known to store attributes of a data structure in memory.

In an attempt to further describe his/her position, the examiner urges that the "ObjectMan" disclosure of Zarmer, at column 11, lines 13-37, and column 12, lines 10-34, somehow suggests the claimed "automatically extracting of attribute data from the document..." We agree with appellants that "ObjectMan" may provide various services for persistent objects, or objects which are saved in a database, wherein such services may include automatic retrieval of an object, automatic deletion of an object from memory, etc., but there is no suggestion therein of the steps of automatically extracting attribute data from an imported electronic document, generating a separate data structure, in which the extracted attribute data is stored and maintained in memory separate from the imported document, and linking the imported document to an electronic folder *if* the attribute data contained in the data structure matches a set of predefined criteria associated with the electronic folder.

The examiner explains that the folders in Zarmer are object classes (column 23, lines 39-57) and "it is possible to designate the attributes of a method that instantiates a

particular folder class" (answer-page 18). Of course, even if something is "possible," this is not a valid line of reasoning that may lead to a conclusion of obviousness under 35 U.S.C. §103.

The examiner says that Zarmer does not explicitly indicate a method to link the imported documents in a folder but finds that the skilled artisan would have found it obvious "to construct a folder for linking imported documents to avoid processing of the documents that are already registered in a database but process the ones that are imported or newly arrived and thus improve system performance. It would have been within the general knowledge of a person of ordinary skill to use a data, for instance today's date, as an attribute to do so" (answer-page 18). This sounds like a classic case of hindsight to us since the examiner's reasoning appears to be tantamount to saying that something would have been obvious merely because appellants have done it, with no convincing support from anything in the prior art for doing what appellants have done. Of course, the examiner may be correct that system performance is improved, but it appears from the record that appellants are the only ones suggesting the claimed invention.



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The examiner's decision rejecting claims 1-28, 30-46 and 51 under 35 U.S.C. §103 is reversed.

REVERSED



ERROL A. KRASS  
Administrative Patent Judge

Joseph E. Bugno  
JOSEPH E. BUGNO

JOSEPH F. RUGGIERO  
Administrative Patent Judge

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AND  
INTERFERENCES

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Administrative Patent Judge

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